



**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appellant: Vicky Sze

Examiner: Timothy M. Harbeck

Serial No.: 09/827,132

Group Art Unit: 3628

Filed: April 3, 2001

Docket: 2043.264US1

Title: METHOD AND SYSTEM AUTOMATICALLY TO REMIND PARTIES TO A  
NETWORK-BASED TRANSACTION TO COMPLY WITH OBLIGATIONS  
ESTABLISHED UNDER A TRANSACTION AGREEMENT

---

**APPEAL BRIEF UNDER 37 CFR § 41.37**

Mail Stop Appeal Brief- Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

The Appeal Brief is presented in response to the Notice of Panel Decision from Pre-Appeal Brief Review mailed on July 14, 2006 and further in support of the Notice of Appeal to the Board of Patent Appeals and Interferences, filed on June 13, 2006, from the Final Rejection of claims 1-35 of the above-identified application, as set forth in the Final Office Action mailed on February 13, 2006.

The Commissioner of Patents and Trademarks is hereby authorized to charge Deposit Account No. 19-0743 in the amount of \$500.00 which represents the requisite fee set forth in 37 C.F.R. § 41.20(b)(2). The Appellant respectfully requests consideration and reversal of the Examiner's rejections of pending claims.

11/20/2006 MBIZUNES 00000092 190743 09827132  
01 FC:1402 500.00 DA



**APPEAL BRIEF UNDER 37 C.F.R. § 41.37**

**TABLE OF CONTENTS**

	<u>Page</u>
<b><u>1. REAL PARTY IN INTEREST</u></b> .....	2
<b><u>2. RELATED APPEALS AND INTERFERENCES</u></b> .....	3
<b><u>3. STATUS OF THE CLAIMS</u></b> .....	4
<b><u>4. STATUS OF AMENDMENTS</u></b> .....	5
<b><u>5. SUMMARY OF CLAIMED SUBJECT MATTER</u></b> .....	6
<b><u>6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL</u></b> .....	8
<b><u>7. ARGUMENT</u></b> .....	9
<b><u>8. SUMMARY</u></b> .....	14
<b><u>CLAIMS APPENDIX</u></b> .....	15
<b><u>EVIDENCE APPENDIX</u></b> .....	21
<b><u>RELATED PROCEEDINGS APPENDIX</u></b> .....	22

## **1. REAL PARTY IN INTEREST**

The real party in interest of the above-captioned patent application is the assignee, EBAY INC., as evidenced by the assignment from inventor Vicky Sze recorded April 3, 2001 at Reel 011687, Frame 0149.

## **2. RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences known to Appellant that will have a bearing on the Board's decision in the present appeal.

### **3. STATUS OF THE CLAIMS**

The present application was filed on April 3, 2001 with claims 1-35. A non-final Office Action mailed September 1, 2005. A Final Office Action (hereinafter “the Final Office Action”) was mailed February 13, 2006. Claims 1-35 stand twice rejected, remain pending, and are the subject of the present Appeal.

#### **4. STATUS OF AMENDMENTS**

No amendments have been made subsequent to the Final Office Action dated February 13, 2006.

## **5. SUMMARY OF CLAIMED SUBJECT MATTER**

Some aspects of the present inventive subject matter include, but are not limited to reminding a party to a network-based commerce transaction to comply with obligations established in terms of a transaction agreement. An independent method, system and computer readable medium claim along with their respective dependent claims accordingly cover at least these aspects.

Independent claim 1 specifically recites a method to facilitate a network-based commerce transaction including recording establishment of a commerce transaction agreement between the first and second parties for purchase of an offering, wherein the commerce transaction agreement is established utilizing a network-based transaction system (e.g., block 72 of Figure 4, page 12, paragraph 34) and wherein the commerce transaction agreement imposes first and second obligations on the first and second parties (e.g., blocks 76 to 84 of Figure 4, pages 13 to 15, paragraphs 37 to 43), respectively and automatically presenting a reminder option to the first party that is exercisable by the first party to remind the second party to comply with the obligations of the second party imposed under the commerce transaction agreement (e.g., block 86 of Figure 4, pages 15 to 16, paragraph 43, blocks 122 to 134 of Figure 5, pages 17-19, paragraphs 46-52).

Claim 2 is dependent on claim 1 and recites, the method of claim 1 including only automatically presenting the reminder option a predetermined time interval after the establishment of the commerce transaction agreement between the first and second parties (e.g., blocks 80 and 82 of Figure 4, pages 14 and 15, paragraphs 40 and 41).

Independent claim 18 specifically recites a system to facilitate a network-based commerce transaction including a database to record establishment of a commerce transaction agreement between the first and second parties for purchase of an offering (e.g., database 23 of Figure 2, pages 10 and 11, paragraphs 26 to 30), wherein the commerce transaction agreement is established utilizing a network-based transaction system (e.g., network based auction facility 10 of Figure 1, pages 8 and 9, paragraph 23) and wherein the commerce transaction agreement imposes first and second obligations on the first and second parties, respectively and a

communication engine (e.g., page servers 12, picture servers 14, CGI servers 18, search service 20, email servers 21 and database engine server 22, pages, pages 8 and 9, paragraph 23) automatically to present a reminder option to the first party that is exercisable by the first party to remind the second party to comply with the obligations of the second party imposed under the commerce transaction agreement.

Claim 19 is dependent on claim 18 and recites, the system of claim 18 wherein the communication engine (e.g., page servers 12, picture servers 14, CGI servers 18, search service 20, email servers 21 and database engine server 22, pages, pages 8 and 9, paragraph 23) is only automatically to present the reminder option a predetermined time interval after the establishment of the commerce transaction agreement between the first and second parties.

Independent claim 35 specifically recites a computer-readable medium (e.g., main memory 304 and machine readable medium 324 of Figure 9, page 22, paragraphs 62 and 63) storing a sequence of instructions that, when executed by a machine (e.g., computer system 300 including processor 302 of Figure 9, page 22, paragraph 62) cause of the machine to record establishment of a commerce transaction agreement between the first and second parties for purchase of an offering, wherein the commerce transaction agreement is established utilizing a network-based transaction system (e.g., block 72 of Figure 4, page 12, paragraph 34) and wherein the commerce transaction agreement imposes first and second obligations on the first and second parties (e.g., blocks 76 to 84 of Figure 4, pages 13 to 15, paragraphs 37 to 43), respectively and automatically present a reminder option to the first party that is exercisable by the first party to remind the second party to comply with the obligations of the second party imposed under the commerce transaction agreement (e.g., block 86 of Figure 4, pages 15 to 16, paragraph 43, blocks 122 to 134 of Figure 5, pages 17-19, paragraphs 46-52).



## **6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

### *§103 Rejection of the Claims*

Claims 1-35 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Conklin et al. (U.S. 6,141,653, hereinafter “Conklin”) in view of Horn et al. (U.S. Publication No. 2001/0037204 A1, hereinafter “Horn”).

## **7. ARGUMENT**

### ***A) The Applicable Law***

In rejecting claims under 35 U.S.C. 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See *In re Lintner*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on 35 U.S.C. 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

The Federal Circuit court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Prods. Co.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

The M.P.E.P. adopts this line of reasoning, stating:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the

prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

The reference (or references when combined) must teach or suggest all the claim elements. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

***B) Discussion of the rejection of claims 1, 3-18, 20-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conklin et al. (U.S. 6,141,653, hereinafter "Conklin") in view of Horn et al. (U.S. Publication No. 2001/0037204 A1, hereinafter "Horn").***

Claims 1-35 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Conklin in view of Horn. This rejection is respectfully traversed. The combination of the references does not teach or suggest each and every element of the claims.

The present application describes various embodiments for reminding a party to a network-based commerce transaction to comply with obligations established in terms of a transaction agreement. For example, a method to facilitate a network-based commerce transaction commences with the recording of a transaction agreement (e.g., an item purchase transaction) between a buyer and a seller. The transaction agreement is established utilizing a network-based transaction system (e.g., an online auction facility). A reminder option is automatically presented to the seller a predetermined time period after the establishment of the transaction agreement. The seller may exercise the reminder option to cause an electronic reminder (e.g., an e-mail message), to be communicated to one or more buyers, thus encouraging the buyer to comply with obligations established by the commerce transaction agreement (e.g., making payment to the seller).

Conklin discusses a negotiations engine for iterative bargaining where a sponsor creates and administers a community between participants such as buyers and sellers having similar interests; allows a buyer/participant to search and evaluate seller information, propose and negotiate orders and counteroffers that include all desired terms, request sample quantities, and track activity; allows a seller/participant to use remote authoring templates to create a complete Website for immediate integration and activation in the community, to evaluate proposed buyer

orders and counteroffers, and to negotiate multiple variables such as prices, terms, conditions etc., iteratively with a buyer.

However, as conceded to by the Office Action (Pg. 2), Conklin does not disclose, “automatically presenting a reminder option to the first party that is exercisable by the first party to remind the second party to comply with the obligations of the second party imposed under the commerce transaction agreement,” as recited in claim 1.

Applicant respectfully disagrees with the Examiner’s characterization of Horn to provide the elements missing from Conklin. Horn is directed to an on line system that facilitates confidential and secure exchanges of offers and demands between parties to a dispute. The exchange takes place directly between a claimant and a respondent or their representatives without the involvement of third parties, such as mediators or arbitrators. Parties are invited to submit settlement offers in ranges including minimum and maximum dollar amounts for which they are willing to settle the case. Based upon the submitted offers the system determines a settlement amount that fits within the proposed ranges. If no settlement is reached the parties are invited to try again. The system is designed to minimize overhead costs by automatically reminding the parties of a pending settlement offer at selected time intervals, thereby eliminating the need for constant follow up correspondence and telephone calls. (Horn Abstract, emphasis added).

The Final Office Action of February 13, 2006 specifically states Horn teaches the following limitation of claim 1, “presenting a reminder option to the first party that is exercisable by the first party to remind the second party to comply with the obligations of the second party imposed under the commerce transaction agreement.” (Final Office Action, pages 2, 3, and 7) It is respectfully submitted, however, that Horn alone or in combination with Conklin does not teach this limitation.

The focus of Horn is dispute resolution where initial obligations may have been made and those very obligations and associated terms are now under dispute with respect to the two parties. Horn facilitates a secure *exchange of offers and demands* between the two parties. (Horn, Paragraph 0017) “...if a party fails to participate in the negotiation process, *the system automatically sends the party reminders of a pending offer* at certain time intervals (e.g., once a week). (Horn, Paragraph 0027) The language of Horn clearly indicates the reminders are for a

pending offer to settle a dispute and are automatically generated. Additionally, there is nothing in the user interface screenshots of Horn (See, e.g., figures 30-47 and accompanying description) to indicate an exercisable option exists. This is in stark contrast to what is principally recited in the claim language of the present patent application, namely, 1) presenting a reminder option to the first party...to remind the second party to comply with an obligation under a transaction agreement; and 2) the reminder being exercisable by the first party.

In sum, for at least the reasons set forth above, Conklin alone or in combination with Horn does not disclose recording establishment of a commerce transaction agreement between the first and second parties for purchase of an offering, wherein the commerce transaction agreement is established utilizing a network-based transaction system and wherein the commerce transaction agreement imposes first and second obligations on the first and second parties, respectively; and automatically presenting a reminder option to the first party that is exercisable by the first party to remind the second party to comply with the obligations of the second party imposed under the commerce transaction agreement, as principally recited by the independent claims 1, 18, and 35.

As dependent claims are deemed to include the limitations of the claim from which they depend, the arguments presented above also address the rejections against the dependent claims. Accordingly, the rejection of claims 1-35 under 35 U.S.C. § 103(a) should be reversed.

***C) Discussion of the rejection of claim 2 and claim 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Conklin et al. (U.S. 6,141,653, hereinafter “Conklin”) in view of Horn et al. (U.S. Publication No. 2001/0037204 A1, hereinafter “Horn”).***

The Examiner in the Final Office Action suggests without explanation that paragraph 0099 of Horn describes claim 2 (and claim 19 under “same rationale”), which recites, “automatically presenting the reminder option a predetermined time interval after the establishment of the commerce transaction agreement between the first and second parties.” However, paragraph 0099 of Horn merely discusses expiration terms of a settlement offer and serves as no basis for describing the presenting of a reminder option for a predetermined time interval. Please compare the text of paragraph 0099 with the claim language and specifically to a “reminder option.”

Consequently, Conklin alone or in combination with Horn does not disclose what is recited in claims 2 and 19 and these rejections should be reversed.

## 8. SUMMARY

For the reasons argued above, claims 1-35 were not properly under 35 U.S.C. § 103(a) as being unpatentable over Conklin in view of Horn.

It is respectfully submitted that the art cited does not render the claims obvious and the claims are thus patentable over the cited art. Reversal of the rejection and allowance of the pending claim are respectfully requested.

Respectfully submitted,

VICKY SZE

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

P.O. Box 2938

Minneapolis, MN 55402

Date November 14, 2006

By



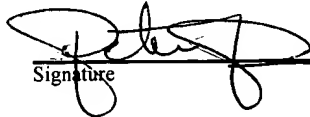
Larry J. Johnson

Reg. No. 56,861

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 14 day of November 2006.

Peter Rubiconi

Name



Signature

---

### **CLAIMS APPENDIX**

1. A method to facilitate a network-based commerce transaction, the method including:  
  
recording establishment of a commerce transaction agreement between the first and second parties for purchase of an offering, wherein the commerce transaction agreement is established utilizing a network-based transaction system and wherein the commerce transaction agreement imposes first and second obligations on the first and second parties, respectively; and  
  
automatically presenting a reminder option to the first party that is exercisable by the first party to remind the second party to comply with the obligations of the second party imposed under the commerce transaction agreement.
2. The method of claim 1 including only automatically presenting the reminder option a predetermined time interval after the establishment of the commerce transaction agreement between the first and second parties.
3. The method of claim 2 wherein the predetermined time interval is at least three days.
4. The method of claim 1 including automatically disabling the reminder option after the issuance of a predetermined number of reminders to the second party by exercising of the reminder option by the first party.
5. The method of claim 1 wherein the reminding of the second party comprises issuing an electronic communication to the second party.



- 
6. The method of claim 5 wherein the electronic communication includes any one of a group of communications including an electronic mail message, a page message, a wireless access protocol (WAP) message, a simple message service (SMS) message and a display on a markup language document.
7. The method of claim 1 wherein the first party comprises a seller of the offering and the second party comprises a buyer of the offering, and wherein the reminder option comprises an option to communicate a payment reminder to the buyer of the offering to provide a payment to the seller of the offering.
8. The method of claim 1 wherein the first party comprises a buyer of the offering and the second party comprises a seller of the offering, and wherein the reminder option comprises an option to communicate a delivery reminder to the seller of the offering to deliver the offering to the buyer.
9. The method of claim 1 wherein the commerce transaction agreement is concluded between the first and second parties utilizing a network-based auction facility, and wherein the recording of the establishment of the commerce transaction agreement is performed at the network-based auction facility.
10. The method of claim 1 wherein the commerce transaction agreement is concluded between first and second parties utilizing a peer-to-peer trading system, and wherein the recording of the establishment of the commerce transaction agreement is performed at a computer systems of the first party.
11. The method of claim 1 wherein the automatic presentation of the reminder option comprises presenting a reminder display element utilizing a graphical user interface, the reminder display element being user-selectable to initiate a reminder process.

- 
12. The method of claim 11 wherein the reminder display element comprises any one of a group of elements including a graphic element and a text element.
  
  13. The method of claim 11 wherein the graphical user interface comprises a markup language document.
  
  14. The method of claim 11 wherein the reminder display element is displayed in association with description information regarding the commerce transaction.
  
  15. The method of claim 11 wherein the reminder display element is displayed in a first state prior to the expiration of a predetermined time interval after the establishment of the commerce transaction agreement to indicate that the reminder option is unavailable until after expiration of the predetermined time interval.
  
  16. The method of claim 15 wherein the reminder display element is displayed in a second state subsequent to exercising of the reminder option a predetermined number of times by the first party.
  
  17. The method of claim 16 wherein the reminder display element is displayed in a third state to indicate that the reminder option is available to the first party after the expiration of the predetermined time interval and prior to the exercising of the reminder option a predetermined number of times by the first party.
  
  18. A system to facilitate a network-based commerce transaction, the system including:
    - a database to record establishment of a commerce transaction agreement between the first and second parties for purchase of an offering, wherein the commerce transaction agreement is established utilizing a network-based transaction system and wherein the commerce transaction agreement imposes first and second obligations on the first and second parties, respectively; and

a communication engine automatically to present a reminder option to the first party that is exercisable by the first party to remind the second party to comply with the obligations of the second party imposed under the commerce transaction agreement.

19. The system of claim 18 wherein the communication engine is only automatically to present the reminder option a predetermined time interval after the establishment of the commerce transaction agreement between the first and second parties.

20. The system of claim 19 wherein the predetermined time interval is at least three days.

21. The system of claim 18 wherein the communication engine is automatically to disable the reminder option after the issuance of a predetermined number of reminders to the second party by exercising of the reminder option by the first party.

22. The system of claim 18 wherein the communication engine is automatically to issue an electronic communication to the second party to remind the second party to comply with the obligations of the second party.

23. The system of claim 22 wherein the electronic communication includes any one of a group of communications including an electronic mail message, a page message, a wireless access protocol (WAP) message, a simple message service (SMS) message and a display on a markup language document.

24. The system of claim 18 wherein the first party comprises a seller of the offering and the second party comprises a buyer of the offering, and wherein the reminder option comprises an option to communicate a payment reminder to the buyer of the offering to provide a payment to the seller of the offering.

25. The system of claim 18 wherein the first party comprises a buyer of the offering and the second party comprises a seller of the offering, and wherein the reminder option comprises an option to communicate a delivery reminder to the seller of the offering to deliver the offering to the buyer.

26. The system of claim 18 wherein the commerce transaction agreement is concluded between the first and second parties utilizing a network-based auction facility, and wherein the database to record the establishment of the commerce transaction agreement is located at the network-based auction facility.

27. The system of claim 18 wherein the commerce transaction agreement is concluded between first and second parties utilizing a peer-to-peer trading system, and wherein the database to record the establishment of the commerce transaction agreement is located at a computer systems of the first party.

28. The system of claim 18 wherein the communication engine is to present a reminder display element utilizing a graphical user interface, the reminder display element being user-selectable to initiate a reminder process.

29. The system of claim 28 wherein the reminder display element comprises any one of a group of elements including a graphic element and a text element.

30. The system of claim 28 wherein the communication engine includes a page server, and wherein graphical user interface comprises a markup language document.

31. The system of claim 28 wherein the communication engine is to display the reminder display element in association with description information regarding the commerce transaction.

---

32. The system of claim 28 wherein the communication engine is to display the reminder display element in a first state prior to the expiration of a predetermined time interval after the establishment of the commerce transaction agreement to indicate that the reminder option is unavailable until after expiration of the predetermined time interval.

33. The system of claim 32 wherein the truncation engine is to display the reminder display element in a second state subsequent to exercising of the reminder option a predetermined number of times by the first party.

34. The system of claim 33 wherein the communication engine is to display the reminder display element in a third state to indicate that the reminder option is available to the first party after the expiration of the predetermined time interval and prior to the exercising of the reminder option a predetermined number of times by the first party.

35. A computer-readable medium storing a sequence of instructions that, when executed by a machine, cause of the machine to:

record establishment of a commerce transaction agreement between the first and second parties for purchase of an offering, wherein the commerce transaction agreement is established utilizing a network-based transaction system and wherein the commerce transaction agreement imposes first and second obligations on the first and second parties, respectively; and

automatically present a reminder option to the first party that is exercisable by the first party to remind the second party to comply with the obligations of the second party imposed under the commerce transaction agreement.

## **EVIDENCE APPENDIX**

None.

**RELATED PROCEEDINGS APPENDIX**

None.